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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,945	07/19/2001	Akira Wakabayashi	892_019	1922

25191 7590 08/09/2004

BURR & BROWN
PO BOX 7068
SYRACUSE, NY 13261-7068

EXAMINER

BERGIN, JAMES S

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/908,945

Applicant(s)

WAKABAYASHI, AKIRA

Examiner

James S. Bergin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003 and 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 5 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Species 2, claims 3, 5 and 10 in the reply filed on 5/17/2004 is acknowledged. The traversal is on the ground(s) *"that species 1-3 are sufficiently related that a thorough and complete search for all three species could be conducted by the USPTO without serious burden"*. This is not found persuasive because each species requires a separate and divergent search strategy that would place an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.
As a courtesy to the applicant, the examiner will include claim 4 of the non-elected species 1 in the following action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US 5,845,265 A) in view of Friedland et al. (US 6,449,601 B1).

Woolston et al. disclose an online trading system comprising: sale receiving means for receiving submission for sale of an article from a seller terminal; information inputting means for inputting information about the article; information storing means for storing the information about the article input from said information inputting means (col. 2, line 20 – col. 4, line 58); auction selecting means for selecting an auction at which the

article is to be auctioned; information showing means for showing the information about the article to public via communicating means and bid submission receiving means for receiving bid submissions for the article at the auction (col. 4, line 60 – col. 6, line 67). Prior to any auction, Woolston et al. disclose that the participant may decide to buy or make a pre auction offer (**a prior bid**) on a particular article via the communication means (col. 5, line 3-5 and col. 13, lines 45 – 57).

However, Woolston et al. fail to disclose successful bid determining means for determining a successful bid based on the information received by said prior bid receiving means and the information received by said bid submission receiving means.

Friedland et al. (US 6,449,601 B1) disclose an online auction including successful bid determining means for determining a successful bid based on the information received by prior bid receiving means and the information received by bid submission receiving means, wherein said successful bid determining means compares a highest price received by said prior bid receiving means with a highest price received by said bid submission receiving means, and determines that the article is sold at a higher price of the two submissions. (col. 6, lines 14-52).

It would have been obvious, in view of Friedland et al., to one of ordinary skill in the art at the time that the invention was made, to provide the Woolston et al. auction system with bid determining means for determining a successful bid based on the information received by the Woolston et al. prior bid receiving means and the information received by the Woolston et al. bid submission receiving means, so as to increase competition in the auction process by including the pre auction offers (prior

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bids) of Woolston et. al. in the auction process. In Woolston et al's auction system as modified by Friedman et al., the successful bid determining means would compare a highest price received by said prior bid receiving means with a highest price received by the bid submission receiving means, and determine that the article be sold at a higher price of the two submissions.

4. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US 5,845,265 A) in view of Friedland et al. (US 6,449,601 B1) as applied to claims 3 and 4 above, and further in view of Fujisaki (US 4,789,928 A).

The combination of Woolston in view of Friedland et al. does not teach that the winning bid is adjusted by adding a unit price to the highest bid submission received by the bid submission receiving means. However, Fujisaki discloses a unit price adjustment means for adding a unit price adjustment to an auction bid (col. 7, lines 24-35; col. 12, lines 16-50, and figures 6 and 16). The examiner takes official notice that an incremental amount can be added to an auction winning bid to defray some of the auction house costs. It would have been obvious, in view of Fujisaki and the above official notice, to one of ordinary skill in the art at the time that the invention was made, to provide the online auction system of Woolston in view of Friedland et al. with unit price adjustment means for adding a unit price adjustment to the winning bid to help defray some of the auction house costs.

Response to Arguments

5. Applicant's arguments with respect to claims 3-6 have been considered but are moot in view of the new ground(s) of rejection.

In the paper filed 12/3/2003, the applicant states that "Claims 3, 4, and 6" have been amended to correct matters of form only". New claims 10 and 11 have also been added. However, these amendments added substantial new limitations to the amended claims and required the examiner to abandon the original rejection in view of Fisher et al. and make the new grounds of rejection as outlined above. Hence this new rejection is properly made final.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 1 178 420 A2 (TSUBASA SYSTEM CO. LTD – Wakabayashi, Akira).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

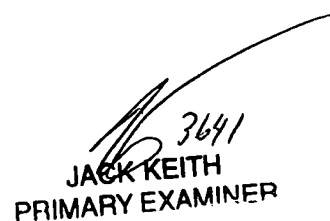
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday - Wednesday and Friday, 8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703 306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James S. Bergin



JACK KEITH
PRIMARY EXAMINER